

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 9, 10, 18, 19, 27, 28, and 36-38 are pending in the present application, Claims 1, 9, 10, 18, 19, 27, 28, and 36-38 having been amended, and Claims 4-8, 13-17, 22-26, and 31-35 having been canceled without prejudice or disclaimer. Support for the amendments to Claims 1, 9, 10, 18, 27, 28, and 36-38 is found, for example, in the originally filed specification and claims.<sup>1</sup> Applicants respectfully submit that no new matter is added.

In the outstanding Office Action, Claims 1, 4, 7, 8, 10, 13, 16, 17, 19, 22, 25, 26, 28, 31, 32, 34, 35, 37, and 38 were rejected under 35 U.S.C. §112, second paragraph; Claims 1, 10, 15, 19, 24, 28, 31, 32, 33, 37, and 38 were rejected under 35 U.S.C. §102(e) as anticipated by Friend (U.S. Patent No. 6,728,757); Claims 4, 5, 7, 13, 14, 16, 22, 23, 25, 31, 32, and 34 were rejected under 35 U.S.C. §103(a) as unpatentable over Friend in view of Kakimoto (U.S. Patent No. 6,775,688); Claims 8, 17, 26, and 35 were rejected under 35 U.S.C. §103(a) as unpatentable over Friend in view of Kakimoto, and further in view of Merritt et al. (U.S. Patent No. 6,421,429, hereinafter Merritt); and Claims 9, 18, 27, and 36 were rejected under 35 U.S.C. §103(a) as unpatentable over Bowker et al. (U.S. Patent Publication No. 2001/0039615, hereinafter Bowker).

Applicants respectfully submit that the rejections of Claims 4-8, 13-17, 22-26, and 31-35 are moot in view of the cancellation of these claims.

With respect to the remaining rejections under 35 U.S.C. §112, second paragraph, the pending claims are amended to more clearly describe and distinctly claim the subject matter regarded as the invention. Claim 1 is amended to clarify that the transmission unit is

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<sup>1</sup> For example, see Applicants' Fig. 13 and its corresponding description.

configured to transmit the E-mail information including a converted image file. A similar amendment is made to Claims 10, 19, 28, 37, and 38.

Applicants respectfully submit that amended Claim 1 patentably distinguishes over Friend. Amended Claim 1 recites,

An information processing apparatus configured to transmit an E-mail information, said E-mail information including an E-mail message body and an attached image file to a reception terminal, the apparatus comprising:

an accommodating capability verifying unit configured to verify an information accommodating capability in at least a reception terminal or in a communication system encompassing said reception terminal, based only on a domain of an E-mail address used in sending the E-mail information to said reception terminal, wherein said information accommodating capability includes maximum number of colors to be displayed by the reception terminal, a maximum image size to be displayed by the reception terminal, a file format of an image that can be displayed by the reception terminal, and a maximum file size of attachment to be received by the reception terminal;

an information converting unit configured to convert the attached image file to include a number of colors equal to a maximum number of colors allowed by the reception terminal, to be equal to the maximum image size to be displayed by the reception terminal to generate a first image file, and then to convert the first image file into a format matching the file format in the information accommodating capability to generate a second image file, and to adjust and reset a size of the second image file and the number of colors in the second image file in order to cause the second image file to be a size less than the maximum size receivable by the reception terminal in response to a determination that the second image file is larger than a maximum size receivable by the reception terminal; and

a transmission unit configured to transmit said E-mail information including a converted image file.

Friend does not disclose or suggest every element of amended Claim 1.

Friend describes sending an E-mail to a recipient and determining if they are HTML capable. If they are HTML capable, then a document is sent as HTML. If the recipient is not HTML capable, then the document is converted to plain text.<sup>2</sup>

Friend does not disclose or suggest at least the claimed “an information converting unit configured to convert the attached image file to include a number of colors equal to a maximum number of colors allowed by the reception terminal, to be equal to the maximum image size to be displayed by the reception terminal to generate a first image file, and then to convert the first image file into a format matching the file format in the information accommodating capability to generate a second image file, and to adjust and reset a size of the second image file and the number of colors in the second image file in order to cause the second image file to be a size less than the maximum size receivable by the reception terminal in response to a determination that the second image file is larger than a maximum size receivable by the reception terminal.”

Friend is only concerned with a conversion between HTML and plain text. There is no disclosure or suggestion of such factors as: maximum number of colors to be displayed by the reception terminal, a maximum image size to be displayed by the reception terminal, and a maximum file size of attachment to be received by the reception terminal. Furthermore, Friend does not disclose or suggest using these factors as claimed in the “an information converting unit configured to....”

Kakimoto does not cure the above-noted deficiencies in Friend. Kakimoto was relied upon to describe transmitting link data instead of an actual file attached to an email. Kakimoto does not disclose or suggest the claimed “an information converting unit configured to convert the attached image file to include a number of colors equal to a maximum number of colors allowed by the reception terminal, to be equal to the maximum

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<sup>2</sup> Friend, col. 3, lines 8-22.

image size to be displayed by the reception terminal to generate a first image file, and then to convert the first image file into a format matching the file format in the information accommodating capability to generate a second image file, and to adjust and reset a size of the second image file and the number of colors in the second image file in order to cause the second image file to be a size less than the maximum size receivable by the reception terminal in response to a determination that the second image file is larger than a maximum size receivable by the reception terminal.”

Merritt does not cure the above-noted deficiency in Friend. Merritt describes that a sending party may transmit an image in any of multiple formats of an arbitrary medium, where the format may be based on a set of parameters, such as compression method, resolution, and number of colors. The receiving party may have established with the network service a profile that preferably specifies which formats it supports, as well as its capabilities and/or preferences in terms of other image parameters, such as resolution and number of colors.<sup>3</sup> However, Merritt does not disclose or suggest the claimed

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The invention defined by Claim 1 describes specifically how the attached image file is converted (particularly the order of the conversion algorithm recited in the above-noted claim

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<sup>3</sup> Merritt, col. 10, lines 25-43.

language). While Merritt mentions multiple formats for images and number of colors, Merritt does not disclose or suggest the details of how the conversion of the attached image file is accomplished as recited in amended Claim 1.

Bowker does not cure the above-noted deficiencies in Friend. Bowker describes that information identifying a preferred data format of each receiver is stored in a database in the broker application server. If the data is not in the preferred format of the addressed receiver, the data is transcoded into a common or raw data format and further transcoded into the preferred data format.<sup>4</sup> However, Bowker does not disclose or suggest the claimed

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The invention defined by Claim 1 describes specifically how the attached image file is converted (particularly the order of the conversion algorithm recited in the above-noted claim language). While Bowker mentions a format conversion, Bowker does not disclose or suggest the details of how the conversion of the attached image file is accomplished as recited in amended Claim 1.

As none of the cited references disclose or suggest the claimed

an information converting unit configured to convert the attached image file to include a number of colors equal to a maximum number of colors allowed by the reception terminal, to be equal to the maximum image size to be

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<sup>4</sup> Bowker, abstract.

displayed by the reception terminal to generate a first image file, and then to convert the first image file into a format matching the file format in the information accommodating capability to generate a second image file, and to adjust and reset a size of the second image file and the number of colors in the second image file in order to cause the second image file to be a size less than the maximum size receivable by the reception terminal in response to a determination that the second image file is larger than a maximum size receivable by the reception terminal,

Applicants respectfully submit that a person of ordinary skill in the art could not properly combine Friend, Kakimoto, Merritt, and Bowker to arrive at the invention defined by Claim 1.

In view of the above-noted distinctions, Applicants respectfully submit that amended Claim 1 (and any claims dependent thereon) patentably distinguish over Friend, Kakimoto, Merritt, and Bowker, taken alone or in proper combination. Claims 10, 19, 28, 37, and 38 recite elements similar to those of amended Claim 1. Applicants respectfully submit that Claims 10, 19, 28, 37, and 38 (and any claims dependent thereon) patentably distinguish over Friend, Kakimoto, Merritt, and Bowker, taken alone or in proper combination, for at least the reasons stated for Claim 1.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

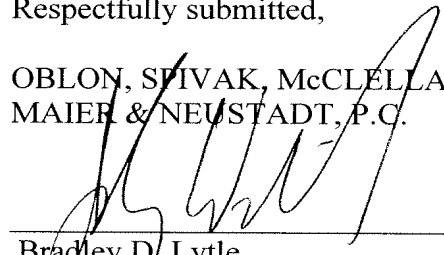
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